

only for said call when the alert sound is being generated and  
a predetermined operation is [operated] specified by the user,  
while leaving a communication status between the remote caller  
and the communication apparatus unchanged.--

--17. (Thrice Amended) The method of informing a user  
of a received call according to claim 13, wherein said step of  
changing the [state] volume of the alert sound includes the step  
of operating a toggling [said predetermined operation] means.--

--18. (Thrice Amended) The method of informing a user  
of a received call according to claim 13, wherein

[said state of] the alert ringing sound is changed to  
[the state where said] stop the alert sound [is stopped] only for  
said call.--

--19. (Thrice Amended)) The method of informing a user  
of a received call according to claim 13, wherein

[said state of] the alert ringing sound is changed to  
[the state where] reduce a volume level of [said] the alert sound  
[is reduced] only for said call.--

#### REMARKS

Claims 1-19 remain in the application with claims 1-3,  
8-10, 13 and 17-19 having been amended hereby.

Reconsideration is respectfully requested of the  
rejection of claims 1 and 11-13 under 35 U.S.C. 102(e), as being

anticipated by U.S. Patent No. 5,657,372 issued to Ahlberg et al.

Ahlberg et al. relates to a cellular radio communications system which permits a user of a cellular telephone to accept a telephone call from another telephone while delaying the establishment of voice communications with the other telephone until the user provides a predetermined signal. Thus, the user can accept the telephone call without hindering his/her current activities and can delay establishment of voice communications with the calling party until the user has completed those activities.

Anticipation under 35 U.S.C. § 102 requires the presence of each and every element of a claimed invention in a single prior art disclosure. Kegel Co. v. AMF Bowling, Inc., 127 F.3d 1420, 1429, 44 U.S.P.Q.2d 1123 (Fed. Cir. 1997) (35 U.S.C. §102(b)); Hazani v. U.S. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 U.S.P.Q.2d 1358 (Fed. Cir. 1997) (35 U.S.C. §102(e)); Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 U.S.P.Q.2d 1565 (Fed. Cir. 1995) (35 U.S.C. §102(a)).

While Ahlberg et al. describes providing the user with means for accepting an incoming telephone call without conversing with the calling party such that the user can continue his/her present activities, Ahlberg et al. describes at col. 3, lines 48-61 that when the user operates the hold selection means, it is preferred that a predetermined message announcing the acceptance of the telephone call is transmitted to the caller. Ahlberg et al. further describes at col. 4, lines 27-33 that during the hold state triggered by the user operating the hold selection means

a communication link is established even though the speaker and microphone of the telephone are not activated.

Therefore, Ahlberg et al. does not disclose or suggest (1) controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and the remote caller remains unchanged, as set forth in claim 1, and (2) changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13.

Further, Ahlberg et al. does not disclose or suggest controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user. Indeed, Ahlberg et al. does not even mention volume of the alert sound at all.

Since Ahlberg et al. does not disclose each and every element of the claimed invention recited in claims 1 and 13, Ahlberg et al. cannot anticipate the claimed invention.

Should the examiner disagree therewith, it is respectfully requested that the examiner specify where in the cited document there is a basis for such disagreement.

Claims 11 and 12 depend directly from claim 1 which for the reasons set forth hereinabove is thought to be patentably distinct over the cited prior art and for at least those very same reasons, claims 11 and 12 are also submitted to be patentably distinct thereover.

Reconsideration is respectfully requested of the rejection of claims 2-5, 14, 15, 18 and 19 under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 5,657,372 issued to Ahlberg et al.

The examiner suggests that the invention recited in claims 2-5, 14, 15, 18 and 19 is substantially disclosed by Ahlberg et al. The examiner admits, however, that Ahlberg et al. does not disclose each and every element of claims 2-5, 14, 15, 18 and 19.

Regarding claims 2 and 18, the examiner admits that Ahlberg et al. does not disclose that the control means controls the alert sound generator to stop the alert sound. The examiner, however, alleges that since Ahlberg et al. describes a controller for controlling the operations of the cellular and the user of the telephone can accept the telephone call without establishing voice communication with the caller by activating a hold selection means, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to use a control means for controlling the alarm sound generator in order to communicate with the caller only when it's convenient for the user.

Regarding claims 3 and 19, the examiner admits that Ahlberg et al. fails to disclose that the control means controls the alert sound generator to reduce the volume of the alert sound. The examiner, however, alleges that since control means that control the state of an alert sound generator to reduce the volume of the alert sound are well known in the art such as ringer controls for controlling the volume of ringing in telephones, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to use a control means to control the alert sound generator to reduce the volume of the alert sound in order not to disturb other people who are working along with the user.

Regarding claims 4, 5 and 15, the examiner admits that Ahlberg et al. fails to disclose a power key. The examiner, however, alleges that since power keys are well known in the art such as in telephone keypads in order to operate a telephone by pressing an on/off switch and a user whose telephone is ringing can place the call off hook to cancel the ringing by depressing the power key, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to use a power key in order to turn a telephone on or off.

Regarding claim 14, the examiner admits that Ahlberg et al. fails to disclose depressing a predetermined key for a time shorter than a predetermined period of time. The examiner, however, alleges that since Ahlberg et al. discloses activating the hold selecting means, it would have been obvious to one of ordinary skill in the art at the time that the invention was made

to require depressing a predetermined key for a time shorter than a predetermined period in order to place the caller on hold.

First, as stated hereinabove, Ahlberg et al. fails to disclose or suggest (1) controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and the remote caller remains unchanged, as set forth in claim 1 from which claims 2-5 depend either directly or indirectly, and (2) changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claims 14, 15, 18 and 19 depend either directly or indirectly.

Since the conventional ringer control feature changes the volume of the ringing permanently until the ringer control is operated by the user again, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the system of Ahlberg et al. to incorporate the conventional ringer control, the modified system would still fail to disclose or suggest (1) controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and

the remote caller remains unchanged, as set forth in claim 1 from which claims 2-5 depend either directly or indirectly, and (2) changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claims 14, 15, 18 and 19 depend either directly or indirectly.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the system of Ahlberg et al. in the manner suggested by the examiner, the modified system would nevertheless fail to disclose the claimed invention.

Further, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art at the time of the invention to modify the system of Ahlberg et al. in the manner suggested by the examiner nor to incorporate other elements of the claimed invention that are not disclosed or suggested by Ahlberg et al., with using the present invention as a read map.

The examiner is reminded that the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art itself suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 (Fed Cir. 1992). It has long been established that obvious-to-try, which is the situation in which the prior art gives only general guidance, but no motivation, as

to the particular form of the claimed invention or how to achieve it, In re O'Farrell, 853 F.2d 894, 903, 7 U.S.P.Q.2d 1673, 1681 (Fed. Cir. 1988), is simply not enough to show §103 obviousness. In re Deuel, 51 F.3d 1552, 1559, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995). The motivation to combine cannot come from the present invention. Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, 21 F.3d 1068, 1072 (Fed. Cir. 1994). A teaching away from the claimed invention by a prior art reference is strong evidence that modification of the prior art to obtain the claimed invention would not have been obvious. Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 885, 45 U.S.P.Q.2d 1977 (Fed. Cir. 1998).

There is neither a teaching nor a suggestion in Ahlberg et al. of a motivation to modify the system to change a volume of the alert sound only for the received call when the user performs a predetermined operation, while leaving a communication status between the remote caller and the communication apparatus unchanged.

Ahlberg et al. does not mention at all the issue of the alert sound disturbing people in the physical proximity of the user. Therefore, Ahlberg et al. provides no motivation for one of ordinary skill to modify the system of Ahlberg et al. to incorporate any means for controlling the alert sound, much less change a volume of the alert sound only for the received call.

In addition, the conventional ringer control provides only general guidance for controlling the alert sound. While the conventional ringer control perhaps provides basis for obvious-



to-try, it simply does not constitute the motivation to one of ordinary skill in the art for modifying the system of Ahlberg et al. to incorporate the claimed features that is required for §103 obviousness.

Further, as stated hereinabove, Ahlberg et al. teaches that when the user operates the hold selection means, it is preferred that a predetermined message announcing the acceptance of the telephone call is transmitted to the caller. Ahlberg et al. further teaches that during the hold state triggered by the user operating the hold selection means a communication link is established even though the speaker and microphone of the telephone are not activated. Therefore, Ahlberg et al. not only does not provide motivation for but actually teaches away from leaving a communication status between the remote caller and the communication apparatus unchanged while changing a volume of the alert sound for the received call only when the user specifies the predetermined operation.

Accordingly, it is respectfully submitted that if it would not have been obvious for one of ordinary skill in the art at the time of the invention to modify the system of Ahlberg et al. to incorporate these features without using the present invention as a roadmap.

Reconsideration is respectfully requested of the rejection of claim 16 under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 5,657,372 issued to Ahlberg et al. in view of U.S. Patent No. 5,276,729 issued to Higuchi et al.

The examiner suggests that the invention recited in claim 16 is substantially disclosed by Ahlberg et al. However, Ahlberg et al., as the examiner admitted, does not disclose or suggest that the predetermined period of time is substantially equal to one second.

The examiner asserts that the deficiencies of Ahlberg et al. are cured by Higuchi et al., and that it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg et al. and Higuchi et al.

As stated hereinabove, Ahlberg et al. fails to disclose or suggest changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claim 16 depends indirectly.

Higuchi et al. fails to cure the deficiencies of Ahlberg et al.

Higuchi et al. relates to a radiotelephone which is remotely programmable and controllable using dual-tone, multiple-frequency tones.

While Higuchi et al. describes that the radiotelephone has conventional keypad buttons which may be used by the user for controlling the volume level of the ringer and the ringer tone, Higuchi et al., like Ahlberg et al., does not disclose or suggest changing a volume of the alert sound only for the received call

when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claim 16 depends indirectly.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg et al. and Higuchi et al. in the manner suggested by the examiner, the combination would nevertheless fail to disclose the claimed invention because neither Ahlberg et al. nor Higuchi et al. discloses or suggests changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claim 16 depends indirectly.

Reconsideration is respectfully requested of the rejection of claims 6-10 and 17 under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 5,657,372 issued to Ahlberg et al. in view of U.S. Patent No. 5,491,745 issued to Roeder and U.S. Patent No. 5,406,618 issued to Knuth et al.

The examiner suggests that the invention recited in claims 6-10 and 17 is substantially disclosed by Ahlberg et al. However, Ahlberg et al., as the examiner admitted, does not disclose or suggest that the control means breaks off power when

the power key is depressed for at least a predetermined period of time and the control means changes the alert sound when the power key is depressed for an amount of time that is shorter than the predetermined period.

The examiner asserts that the deficiencies of Ahlberg et al. are cured by Roeder and Knuth et al., and that it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg et al., Roeder and Knuth et al.

As stated hereinabove, Ahlberg et al. fails to disclose or suggest (1) controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and the remote caller remains unchanged, as set forth in claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claim 17 depends directly.

Roeder and Knuth et al. fail to cure the deficiencies of Ahlberg et al.

Roeder relates to a telephone apparatus which retrieves and dials previously stored telephone or billing account numbers by pressing one of the keys of a standard 12-key keypad. On

the occurrence of such action, a telephone set controller accesses a memory location which is uniquely associated with the depressed key, and causes the out dialing of the telephone number prestored in such location.

While Roeder describes a dual mode keypad permitting one touch dialing, Roeder, like Ahlberg et al., does not disclose or suggest (1) controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and the remote caller remains unchanged, as set forth in claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claim 17 depends directly. Indeed, Roeder, like Ahlberg et al., does not even mention the volume of the alert sound, much less changing the volume of the alert sound only for the received call, at all.

Knuth et al. relates to a telephone answering device that is activated by a proximity sensor when a user crosses its field of detection and whose operation is controlled by simple voice commands. The telephone answering device performs all the basic functions of a telephone answering machine in response to these simple commands and there is no need for the user to

manually operate the telephone answering device.

While Knuth et al. describes one touch dialing, Knuth et al., like Roeder and Ahlberg et al., does not disclose or suggest (1) controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and the remote caller remains unchanged, as set forth in claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claim 17 depends directly. Indeed, Knuth et al., like Roeder and Ahlberg et al., does not even mention the volume of the alert sound, much less changing the volume of the alert sound only for the received call, at all.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg et al., Roeder and Knuth et al. in the manner suggested by the examiner, the combination would nevertheless fail to disclose the claimed invention because neither Ahlberg et al. nor Roeder nor Knuth et al. discloses or suggests (1) controlling the alert sound generator to change a volume of the alert sound only for the received call, when the

alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and the remote caller remains unchanged, as set forth in claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the alert sound only for the received call when the alert sound is being generated and a predetermined operation is specified by the user, while leaving a communication status between the remote caller and the communication apparatus unchanged, as set forth in claim 13 from which claim 17 depends directly.

Should the examiner disagree therewith, it is respectfully requested that the examiner specify where in the cited document there is a basis for such disagreement.

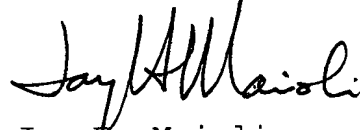
Accordingly, it is respectfully submitted that there is no showing or suggestion in the prior art of record of a communication terminal for informing a user of a received call from a remote caller by an alert sound that includes controlling the alert sound generator to change a volume of the alert sound only for the received call, when the alert sound generator is generating the alert sound and the means for specifying a predetermined operation is operated by the user, while a communication state between the terminal and the remote caller remains unchanged, in any of the proper references for consideration alone or in combination absent the teaching of the present invention as set forth in the claims.

Claims 1-3, 8-10, 13 and 17-19 have been amended hereby to more clearly recite the features of the present invention. Therefore, it is respectfully submitted that the amendments made to the claims hereby raise no new issues requiring further consideration and/or search and, thus, the amendments should be entered.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

COOPER & DUNHAM LLP

A handwritten signature in black ink, appearing to read "Jay H. Maioli". The signature is fluid and cursive, with the first name "Jay" and last name "Maioli" clearly distinguishable.

Jay H. Maioli  
Reg. No. 27,213

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